

**REMARKS**

The restriction requirement and election of species requirement is traversed for the following reasons:

***Restriction Requirement***

- (1) On page 4, lines 12-15 of the restriction requirement, the examiner stated that "Placing all such compounds into the same claims is proper to scientific classification as they are separately classified and require separate searches. Search of all these class of compounds would be a serious search burden."

However, MPEP, Annex B (Unity of Invention), paragraph (f), "Markush Practice", subparagraph (iv) states that "*The fact that the alternatives of a Markush grouping can be differently classified shall not, taken alone, be considered to be justification for a finding of lack of unity of invention.*" (see page AI-54)

Moreover, *none of the 12 groups cited on pages 2-3 of the restriction requirement recite any class, subclass information from the U.S. Patent Classification System* which would provide factual evidence that the each of the groups could be differently classified. The classification system is replete with examples where a single subclass may encompass multiple types of heterocyclic rings (see e.g. Class 536, subclass 6.5).

- (2) The restriction into groups I-XII was based on the identity of the moieties for the variable (T)<sub>x</sub>A. However, no such requirement was placed for the variable B which contained some of the very same moieties as defined for the variable (T)<sub>x</sub>A (i.e. when presented with the opportunity to define the groups by (T)<sub>x</sub>A and B, the examiner elected not to do so) – the only requirement was that the applicants make a "suitable choice". This would appear to indicate that a search for at least two different types of heterocycles would not have constituted an undue burden for the office.
- (3) Since the restriction into groups I-XII was based on the identity of the moieties for the variable (T)<sub>x</sub>A, the examiner is asserting that sole feature common to the groups is the presence of a carboxylic group. However, this is incorrect.

With the applicants' arguments made above, the applicants' would hold that B-D-E-CO<sub>2</sub>H is the common core structure. However, even when assuming the examiner's position, the common core structure is not the carboxylic acid group, but D-E-CO<sub>2</sub>H, i.e.

each of the twelve (12) groups have this structure as part of a common core structure. As such, the application of "Markush practice" as it applies to unity of invention is similar to that described in Examples 18 and 19 of Annex B of the MPEP (see page AI-61), i.e. *the mere recitation of multiple heterocyclic groups in a variable was not sufficient to establish a lack of unity of invention.*

While it would not be necessary to disclose prior art to make an assertion that a carboxylic acid group is known in the art, Annex B, paragraph (c), subparagraph (i) states that "*If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims.*". The restriction requirement did not offer any evidence that the common core structure D-E-CO<sub>2</sub>H was taught in the prior art.

### ***Election of Species Requirement***

Many of the same arguments made above would also apply to the election of species requirement. In addition, the examiner stated that "These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1." The species identified were those of Example 1-43 and a single species was required to be elected. However, it is unclear why:

- (1) When following the examiner's logic for the election of species requirement, why Examples 44-58 were omitted from the election of species requirement (especially with regards to Examples 44-46, 49, 52, 55 and 58); and
- (2) It was deemed that each individual species, 1-43, lacked a common core feature. However, it is unclear why were the examples not organized into specific species classes. (e.g. What is the distinction between the "core structure" for the compounds of Example 5 and 6 – while it is possible to obtain a patented claim to a specific stereoisomer, this is usually only possible when secondary considerations are taken into account)

### ***Closing***

For the reasons given above, it is requested that the restriction requirement and election of species requirements be withdrawn.

Applicants reserve the right to petition any holding of finality for the restriction and election of species requirements and reserve the right to prosecute the subject matter of the non-elected claims in a divisional application, if such subject matter is not ultimately granted here.

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that the foregoing Response to Restriction Requirement (4 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: **19 July 2002**

By

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